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No. 93-1577

IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

QUALITEX COMPANY,

Petitioner,

vs.

JACOBSON PRODUCTS CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

MOTION FOR LEAVE TO FILE AND BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITION

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On Petition For A Writ of Certiorari to the
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for the Ninth Circuit

MOTION FOR LEAVE TO FILE BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE*

The American Bar Association ("ABA") moves pursuant to Rule 37.2 of the rules of this Court for leave to file the annexed brief as *amicus curiae* in support of the Petition for Certiorari filed by Qualitex Company on or about April 4, 1994. The ABA wishes to support the Petitioner's position that the Ninth Circuit's decision is of sufficient importance to merit review on the first issue presented, namely, whether the Lanham Act prohibits the registration of color as a trademark. The ABA believes that the annexed brief will be of assistance to the Court. Although counsel for Petitioner Qualitex Company

consented to the filing of this brief, the consent of counsel for Respondent Jacobson Products Company, Inc. was requested but refused. The ABA therefore requests leave to file the annexed brief as *amicus curiae*.

Respectfully submitted,

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BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITION

INTEREST OF *AMICUS CURIAE*[1]

The American Bar Association ("ABA") is a voluntary, national membership organization of the legal profession. The more than 360,000 members of the ABA come from every state and territory and the District of Columbia. The ABA's

[1] This brief is accompanied by a Motion for Leave to File, consent of respondent having been requested but refused.

constituency includes attorneys in private practice, legislators, law professors, law students and a number of non-lawyer "associates" in related fields.[2]

The Section of Intellectual Property Law ("Section") of the ABA includes over 10,000 ABA members interested and having expertise in intellectual property law, including trademark law. Many members of the Section practice in the field of trademark law, represent trademark owners, their competitors and other persons and businesses affected by trademarks.

Although the ABA has no policy position on the registrability of color trademarks and will not take a position in this particular case, the first question raised in this case[3] -- whether color is registrable as a trademark under the Lanham Act -- is important to the trademark bar, the clients it serves (including trademark owners and users, their competitors and the national public), the United States Patent and Trademark Office and the administration of justice.

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[2] Neither this brief nor the decision to file it should be interpreted to reflect the views of any judicial member of the American Bar Association. No inference should be drawn that any member of the Judicial Administration Division Council has participated in the adoption of or endorsement of the positions in this brief. This brief was not circulated to any member of the Judicial Administration Divisional Council prior to filing.

[3] *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994).

SUMMARY OF THE ARGUMENT

The Ninth Circuit's decision further deepens the split between the circuits and the United States Patent and Trademark Office and adds to the uncertainty concerning the registrability of color as a trademark. This split in the circuits and attendant uncertainty in the law significantly impairs the ability of trademark lawyers to provide informed guidance to clients on matters relating to the registration of color as a trademark. Resolution of this split in the circuits is critical to the interests of the trademark bar and to the clients it serves, including trademark owners and users, their competitors and the national public, as well as to the United States Patent and Trademark Office and the administration of justice.

ARGUMENT

The Ninth Circuit held that, as a matter of law, color cannot be registered as a trademark under the Lanham Act. Accordingly, the Ninth Circuit reversed the district court's judgment that defendant had infringed plaintiff's federally-registered trademark for the color green-gold as applied to dry cleaning press pads. Further, the Ninth Circuit reversed the district court's judgment in favor of plaintiff on defendant's counterclaim for cancellation of plaintiff's federal trademark registration, requiring that plaintiff's registration be canceled.[4]

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[4] The Ninth Circuit did, however, enforce the plaintiff's rights in its trade dress, "the 'total impression' of the Qualitex green-gold pad and its 'SUN GLOW' name." *Accord Keds*

The Ninth Circuit relied on the Seventh Circuit's decision in *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991), that color alone -- there, pastel blue for tabletop sweetener -- is not protectable as a trademark.[5] Both the Seventh and Ninth Circuits cited a policy reason and a prudential reason for denying mere color registration as a trademark. They cited the "color depletion" policy: that allowing color trademark registrations could preclude new competitors from entering an industry once all colors are used and registered. They also relied on the prudential concern of "shade confusion": that deciding likelihood of confusion -- the test for trademark infringement -- between color shades would be difficult. *See NutraSweet*, 917 F.2d at 1027-1028; *Qualitex*, 13 F.3d at 1302.

In contrast to the Ninth and Seventh Circuits, other courts have rejected the "color depletion" and "shade confusion" arguments and have held that there is no per se ban against registration of color as a trademark under the Lanham Act. The Federal Circuit, which hears appeals from the Patent and Trademark Office's Trademark Trial and Appeal Board under

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Corp. v. Renee Int'l Trading Corp., 888 F.2d 215, 221 (1st Cir. 1989) (enforced Keds' trademark registration for rectangular blue label on sneakers without resolving issue of protectability of color).

[5] Because the plaintiff apparently did not own a federal trademark registration, registrability was not before the Seventh Circuit.

28 U.S.C. § 1295(a)(4)(B), has held that color alone is registrable as a trademark under the Lanham Act.[6] The Patent and Trademark Office[7] has followed the Federal Circuit in holding that there is no per se prohibition against registration of color as a trademark under the Lanham Act.[8] The Eighth Circuit[9] and other courts[10] have applied the same reasoning to hold that there is no prohibition to enforcing rights in color as a trademark.

This split among the circuits and the Patent and Trademark Office is of concern to members of the trademark

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[6] *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (color pink registrable as a trademark for fiberglass insulation).

[7] *Edward Weck, Inc. v. IM, Inc.*, 17 U.S.P.Q.2d 1142, 1145 (T.T.A.B. 1990) (no inherent bar to color trademark registration); United States Patent & Trademark Office *Trademark Manual of Examining Procedure* (2nd ed. 1993) (stating guidelines for registration of color trademarks); *see also* Registration No. 1,536,106 published at Pat. Off., Official Gazette, June 7, 1988 (shade of color blue for hand tools).

[8] *See generally* Andrew W. Coleman, *Color as Trademarks: Breaking Down the Barriers of the Mere Color Rule*, 74 J. Pat. & Trademark Off. Soc. 345 (1992) (criticizing the split in the circuits and urging registration of color trademarks).

[9] *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 222-24 (8th Cir. 1993).

[10] *E.g., DAP Prods., Inc. v. Color Tile Mfg., Inc.*, 821 F. Supp. 488, 494 (S.D. Ohio 1993).

bar and the legal profession for four reasons. First, the present state of the law encourages persons and businesses to invest in developing color trademarks and obtaining color trademark registrations, an investment that may turn out to be worthless. Because of the importance of trademarks in allowing competitors to effectively distinguish their goods from each other's and thus facilitating the ability of the consuming public to readily and accurately choose between competing goods, *see* S. Rep. No. 1333, 79th Cong., 2d Sess. (1946); *see also Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942), persons and businesses invest heavily in creating, developing and maintaining trademark rights. Based on the position of the Federal Circuit and the Patent and Trademark Office -- that color is registrable as a trademark -- persons and businesses have invested in creating and developing color trademarks.[11] Registrations for these marks, however,

[11] A federal trademark registration provides the trademark owner with significant advantages over common law rights. *See generally* 1 J. McCarthy, *Trademarks and Unfair Competition*, § 19.5 at 883-84 (2d ed. 1984) (setting forth numerous advantages of a federal registration, some of which include: prima facie evidence of the registrant's ownership and exclusive nationwide right to use the mark; prima facie evidence that the mark has acquired secondary meaning; after five years registration, the mark may become "incontestable" as conclusive evidence of the registrant's exclusive right to use of the mark, subject to limited defenses; and the ability to stop importation into the United States of articles bearing an infringing mark).

are now subject to cancellation, as a matter of law, in at least the Ninth Circuit.[12] Cancellation of a trademark registration by order of a court in the Ninth Circuit would preclude future enforcement of a federal registration in any other court, including those within circuits, like the Eighth, that recognize color trademark registrations. This uncertainty in the law necessarily hampers persons and businesses in planning national marketing and competition strategies involving color trademarks.

Second, the split among the circuits and the Patent and Trademark Office also harms competitors of owners of federal color trademark registrations. These competitors cannot identify where or under what circumstances use of the color would be lawful. Under the present state of the law, a nationwide answer is impossible. And even within the Ninth Circuit, which has rejected registration of color as a trademark, an answer is impossible because an appeal may go to the Ninth Circuit under 28 U.S.C. § 1291 or, if the case involves a patent claim, to the Federal Circuit under 28 U.S.C. § 1295(a)(1).

Third, the present state of the law also wastes the resources of the Patent and Trademark Office. Presently, the Patent and Trademark Office expends significant resources

[12] *See* Jeffrey M. Samuels & Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 Trademark Rep. 554, 570 (1993) (noting that the current uncertainty over the color trademark issue and that businesses may spend time and money to obtain "essentially worthless registrations").

examining color trademark applications and issuing and maintaining color trademark registrations. All of these color trademark registrations are subject to cancellation as a matter of law in the Ninth Circuit.

Finally, the present state of the law is harmful to the administration of justice. Litigation will inevitably ensue because persons and businesses are using, under a claim of right, colors the same as or similar to those on which competitors have federal trademark registrations. The issue of registration of color as a trademark will doubtless continue to be hard fought in the regional circuits that have yet to consider the issue,[13] and there will be forum shopping in the form of countless venue disputes between the circuits that have decided the issue.[14]

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[13] *See* Samuels & Samuels, *supra* note 12, at 570 (noting that if the uncertainty over the color trademark issue is not resolved, litigation over the issue will continue with its attendant costs).

[14] The venue dispute would be all important because the transferee court can apply its circuit's interpretation of substantive federal law and is not required to apply federal law of the circuit in which the transferor court is located. *Center Cadillac, Inc. v. Bank Leumi Trust Co.*, 808 F. Supp. 213, 222 (S.D.N.Y. 1992) (applying law of transferee circuit and noting that conflict of views among the circuits presents a matter for consideration for the Supreme Court on application of certiorari, not for consideration by a district judge on application for transfer).

Because of the waste of judicial and administrative resources and the harm to persons and businesses using color trademarks and their competitors, the ABA believes that the split among the circuits and the Patent and Trademark Office, which is deepened by the Ninth Circuit's decision, raises an issue of nationwide significance that merits this Court's attention.

CONCLUSION

The Petition for a Writ of Certiorari should be granted as to the first question presented.

Respectfully submitted,

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